

### **REMARKS**

After entry of this amendment, claims 15-36 will be pending in this application, for a total of 22 claims, 4 of which are independent. (Accordingly, the requisite fees for two claims more than twenty and one additional independent claim are authorized to be charged in the papers accompanying this response.) Applicant has cancelled original claims 1-14 without prejudice or disclaimer and has entered new claims 15-36 to define the invention with more clarity. Additionally, Applicant has entered two replacement sheets of drawings, containing revised FIGS. 1A and 1B, in order to answer the Examiner's objection. No new matter has been added.

#### **The drawing objection**

FIGS. 1A and 1B were objected to for failing to show the names of the various components depicted in the figures. The two replacement sheets with revised versions of FIGS. 1A and 1B include names for the various components and also depict the scene with more clarity than that afforded by the stick figures of the original drawings. No new matter has been added.

#### **Rejection Under 35 U.S.C. § 101**

Original claim 14 was rejected under 35 U.S.C. § 101 as allegedly being non-statutory. Because claim 14 is cancelled, the rejection is technically moot. However, Applicant notes that original claim 14 did recite "an article of manufacture comprising a computer usable medium" (emphasis added). Therefore, Applicant fails to understand the Examiner's assertion that the claim did "not define a computer-readable medium or memory and [was] thus non-statutory for that reason" and believes the Examiner to be incorrect. In fact, Applicant notes that original claim 14 has almost precisely the same relevant claim language as that found to be patentable in In re Beauregard, 53 F.3d 1583, 35 USPQ.2d 1383 (Fed. Cir. 1995), the canonical case on the subject. Accordingly, to the extent that any of Applicant's pending claims includes that language, or any similar language, Applicant submits that a rejection is improper.

Rejection Under 35 U.S.C. § 102

Original claims 1-14 were rejected under 35 U.S.C. § 102(e) over Kikuchi et al., U.S. Patent No. 6,553,180. Since claims 1-14 are cancelled, the rejection is technically moot. However, Applicant respectfully traverses the rejection nonetheless and will explain why the rejection should not be extended to new claims 15-36.

New method claim 15 recites a combination of features, particularly:

(1) “recording audio/visual data continuously;” and

(2) “allowing a user to mark selected segments of the recorded audio/visual data so as to identify portions of the recorded audio/visual data of significance to the user essentially in real-time without interrupting the recording.”

Thus, in Applicant’s system, a user can record continuously and mark segments of significance to him or her essentially in real-time without interrupting the recording. As recited in claims 17, 22 and others, marked segments may be transferred to archival storage, while unmarked segments may be overwritten.

Applicant respectfully submits that that is not what Kikuchi et al. discloses. Instead, Kikuchi et al. discloses a method, system, and file formats for creating DVD scene menus interactively from a variety of recorded sources. First and foremost, the Kikuchi et al. system does not disclose or suggest recording audio/visual data continuously. It merely discloses that recorded audio/visual data can be amongst the source materials for its automatic scene menu system. The Examiner points to FIG. 31 to show continuous recording from a video camera, but what that figure actually shows is that the recording in question was repeatedly paused.

In the Kikuchi et al. system, one of the key issues is how to determine when one scene has ended and the next has begun. Kikuchi et al. apparently refers to the sequence of scenes as the “program chain,” individual scenes as “program chain cells” and spends a considerable time describing different methods for inserting markers to indicate the divisions between the program chain cells. Beginning in column 26, line 57, describing FIG. 28, and continuing through column 27, line 34, describing FIG. 31, Kikuchi et al. describes various ways of inserting markers between scenes. These include:

(1) A change in video or audio mode;

(2) Based on elapsed video recording time;

- (3) The user recognizing a change of scene manually;
- (4) Based on the use of playback or pause buttons; and
- (5) Based on a change from white frame to black frame or vice-versa.

However, none of these methods meet the language of Applicant's pending claims. None of those methods involve recording continuously and allowing the user to mark segments of recorded data so as to "identify portions...of significance to the user." The Kikuchi et al. system may disclose various methods of marking the start and end of scenes, but it does not allow a user to differentiate between that which is significant and that which is not in real-time while recording continuously. In other words, in Kikuchi et al., a scene is a scene. There is no way to separate the important from the unimportant. To the extent that a user may, in some permutations, give input, that input is limited to the purely mechanistic act of recognizing when one scene ends and another begins.

Applicant also disagrees with the Examiner's conclusion that Kikuchi et al. discloses tagging, or more particularly, as recited in claim 15, "allowing the user to associate at least the marked selected segments of audio/visual data with tag data identifying the content of the marked segments." In concluding that Kikuchi et al. discloses tagging, the Examiner asserts that "the marked segments of A/V data are tagged as PGC1, PGC2, PGC3, PGC4, and PGC5." Applicant disagrees. The Kikuchi et al. system may refer to its scenes as PGC1, etc., but those designations do nothing to describe the content of the scenes, as Applicant's claims recite. They are simply an internal designator that has no meaning to the end user at all.

Moreover, Applicant submits that because Kikuchi et al. does not disclose or suggest tagging, Kikuchi et al. cannot disclose or suggest categorizing the marked selected segments based on the associated tag data.

For at least those reasons, Applicant submits that independent claims 15 and 28, and the claims that depend from them, are not anticipated by Kikuchi et al.

In addition to those noted above, dependent claim 22 and independent claim 28 recite additional features that are neither disclosed nor suggested by Kikuchi et al. Specifically, those claims recite overwriting and selectively erasing some of the unmarked audio/visual data, recitations that are also found in claims 35 and 36. That is not something Kikuchi et al. discloses. As shown in FIG. 57, when space on a recording

medium is limited, the Kikuchi et al. system instructs the user to set a lower recording bit rate or change to a new disc.

Applicant also submits that Kikuchi et al. does not disclose the system of independent claim 24 or the machine-readable medium of claim 34. As Applicant described above, Kikuchi et al. discloses a system for automatically creating DVD menus that is different in components and in purpose from Applicant's system and machine-readable medium.

Thus, Kikuchi et al. does not anticipate Applicant's pending claims, and Applicant submits that the rejection should be withdrawn.

As Applicant has addressed all of the outstanding objections and rejections, this application is believed to be in condition for allowance, and a timely Notice to that effect is respectfully requested. If questions relating to patentability remain, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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